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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91188903
Party	Plaintiff Apple Inc.
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Submission	Motion to Compel Discovery
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Date	03/10/2010
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the matter of Application Serial No. 77/460,315

For the mark: APPLSTRUDL

Filed: April 29, 2008

Published: December 16, 2008

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APPLE INC.,	:	
	:	
Opposer,	:	
	:	
	:	Opposition No. 91188903
v.	:	
	:	
FABASOFT AG,	:	
	:	
Applicant.	:	
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**OPPOSER’S MOTION AND BRIEF IN SUPPORT FOR AN ORDER DEEMING
ITS REQUESTS FOR ADMISSION ADMITTED, TO COMPEL RESPONSES
TO ITS INTERROGATORIES AND REQUESTS FOR PRODUCTION, AND
TO COMPEL PRODUCTION OF DOCUMENTS**

Pursuant to Rules 26, 33, 34, 36, and 37 of the Federal Rules of Civil Procedure, Trademark Rule of Practice 2.120(e) and TBMP §§ 411.01 and 411.02, Opposer Apple Inc. (“Opposer”) respectfully moves the Board for an order:

- (1) Compelling Applicant Fabasoft AG (“Applicant”) to serve Initial Disclosures;
- (2) Deeming the requests in Opposer’s First Requests for Admission admitted by Applicant based on Applicant’s complete failure to respond;
- (3) Compelling Applicant to answer completely, and without objection, Opposer’s First Set of Interrogatories and First Request for Production of Documents; and
- (4) Compelling Applicant to produce documents responsive to Opposer’s First Request for Production of Documents.

I. Factual Background

Opposer commenced this proceeding by filing a notice of opposition against Applicant's application to register the mark APPLSTRUDL (Serial No. 77/460,315) on February 13, 2009. *See* Docket No. 1. Applicant's Initial Disclosures were due on May 29, 2009. *See* Docket No. 2. Applicant failed to serve Initial Disclosures before the May 29, 2009 deadline. *See* Declaration of Alicia Grahn Jones ("Jones Dec.") ¶ 2. On June 30, 2009, Opposer emailed counsel for Applicant asking when Opposer would receive Applicant's Initial Disclosures. *See id.*, Ex. A. On June 30, 2009, counsel for Applicant advised that he had not received any information from Applicant regarding its Initial Disclosures. *See id.*

On June 25, 2009, Opposer served written discovery, including document requests, requests for admission, and interrogatories, on counsel for Applicant. *See* Jones Dec. ¶ 3. Although Applicant's responses to Opposer's discovery requests were due on July 31, 2009, Applicant has yet to serve any response to Opposer's discovery requests or produced any responsive documents. *See id.*

On August 7, 2009, Opposer informed counsel for Applicant that discovery responses were past due and advised that if Opposer did not receive Applicant's responses by August 12, 2009, Applicant would have no choice but to file a motion to compel. *See id.* ¶ 4., Ex. C. Counsel for Applicant failed to respond to Opposer's August 7, 2009 correspondence. *See id.*

On September 21, 2009, November 2, 2009, and December 28, 2009, the parties filed joint motions to suspend the proceedings pending settlement discussions. *See* Docket Nos. 5,7,9. The settlement negotiations were unsuccessful and the proceedings resumed on February 26, 2010. *See* Docket No. 10. Following the resumption of the proceedings, on

February 26, 2010 and March 3, 2010, Opposer again informed counsel for Applicant that discovery responses were past due and advised that if Opposer did not receive Applicant's responses by March 3, 2010, Opposer would seek relief from the Board. *See* Jones Dec. ¶ 5; Ex. D. Despite Opposer's numerous requests, Opposer still has not received a single document or a single discovery response from Applicant. *See id.* Counsel for Opposer has made a good faith effort to resolve the issues presented in this Motion with Applicant. *See id.*, Ex. A, C, and D. Nevertheless, Applicant has refused to respond to Opposer's discovery requests or produce responsive documents. *See id.* ¶ 5. Accordingly, Opposer has no choice but to file this Motion.¹

II. Argument and Citation of Authority

Applicant has a history of dilatory and egregious behavior concerning its use and attempted registration of the APPLSTRUDL mark. Applicant defaulted in an opposition filed by Opposer (Opp. No. 91189904) against Applicant's application to register the mark APPLSTRUDL (Serial No. 77/596,114). Moreover, on February 25, 2009, the Hamburg Regional Court issued an injunction against Applicant concerning its use of the APPLSTRUDL mark. *See* Jones Dec. ¶ 6. Now Opposer is forced to bring this motion because of Applicant's failure to cooperate in the discovery process.

A. Applicant should be compelled to serve Initial Disclosures.

Applicant's Initial Disclosures were due on May 29, 2009. *See* Docket No. 2. However, Applicant failed to serve Initial Disclosures before the May 29, 2009 deadline.

¹ In accordance with Trademark Rule of Practice 2.120(e), Opposer attaches complete copies of its First Requests for Admission, First Set of Interrogatories, and First Request for Production of Documents as **Exhibit B** to the Declaration of Alicia Grahn Jones.

See Jones Dec. ¶ 2. Pursuant to Trademark Rule of Practice 2.120(e), Applicant should be compelled to serve its Initial Disclosures without further delay.

B. The Board should deem Opposer's First Requests for Admission admitted because Applicant failed to respond timely.

TBMP Rule 407.03(a) indicates that “[i]f a party on which requests for admission have been served fails to timely respond thereto, the requests will stand admitted unless the party is able to show that its failure to respond was the result of excusable neglect”

Applicant has submitted no proof of excusable neglect for failing to respond **at all** to Opposer's requests for admission. Consequently, the Board should enter an order deeming Opposer's Requests for Admission admitted by Applicant.

C. Applicant should be compelled to respond without objection to Opposer's First Set of Interrogatories and First Request for Production of Documents.

Federal Rule of Civil Procedure 37(a)(1) and Trademark Rule of Practice 2.120(e) provide that a discovering party may move for an order compelling responses to discovery requests when a party refuses to respond.

Applicant has failed to respond to Opposer's interrogatories and document requests. Therefore, the Board should compel Applicant to respond to its interrogatories and requests for production. See, e.g., TBMP § 523.01; *Miss Am. Pageant v. Petite Prods. Inc.*, 17 U.S.P.Q.2d 1067, 1070 (T.T.A.B. 1990) (granting motion to compel responses to interrogatories); *Am. Soc'y of Oral Surgeons v. Am. Coll. of Oral and Maxillofacial Surgeons*, 201 U.S.P.Q. 531, 534 (T.T.A.B. 1979) (granting motion to compel responses to discovery requests relating to third-party uses of Opposer's mark); *Miller & Fink Corp. v.*

Servicemaster Hosp. Corp., 184 U.S.P.Q. 495, 496 (T.T.A.B. 1975) (granting motion to compel responses to interrogatories regarding Opposer's claims of distinctiveness).

Furthermore, when a party fails to respond timely to a request for discovery, any objections a party may have on the merits of any discovery request are waived. *See* TBMP § 527.01(c); *MacMillan Bloedal Ltd. v. Arrow-M Corp.*, 203 U.S.P.Q. 952, 953 (T.T.A.B. 1979) (“[A] party who fails to respond to a request for discovery during the time allowed therefor is deemed by the Board to have forfeited his right to object to the request on its merits”); *Crane Co v. Shimano Indus. Co.*, 184 U.S.P.Q. 691, 691 (T.T.A.B. 1975) (“Inasmuch as applicant failed to respond to the interrogatories on or before [the deadline], or to request an extension of its time to do so prior to the aforesaid date, applicant has waived its right to object to the interrogatories on their merits and must reply to them as put.”). Because Applicant failed to respond to all of the discovery requests in a timely manner, Applicant is deemed to have waived its right to object to any request.

Applicant is aware that its responses are overdue and it still has yet to provide any discovery responses. Accordingly, the Board should compel Applicant to respond without objection to Opposer's First Set of Interrogatories and First Request for Production of Documents.

D. Applicant should be compelled to produce responsive documents.

Federal Rule of Civil Procedure 37(a)(3)(B) and Trademark Rule of Practice 2.120(e) provide that a discovering party may move for an order compelling production of responsive documents when a party refuses to respond to discovery requests. Because Applicant has failed to produce any responsive documents, the Board should compel Applicant to immediately produce responsive documents. *See, e.g.*, TBMP § 523.01; *Miss Am. Pageant*,

17 U.S.P.Q.2d at 1070 (granting motion to compel production of documents); *Am. Soc’y of Oral Surgeons*, 201 U.S.P.Q. at 534 (granting motion to compel production of documents relating to third-party uses of Opposer’s mark); *Johnson & Johnson v. Diamond Med., Inc.*, 183 U.S.P.Q. 615, 617 (T.T.A.B. 1974) (granting motion to compel production of documents relating to search reports, advertising, and advertising expenditures).

III. Conclusion

For the foregoing reasons, Opposer respectfully requests that the Board compel Applicant to serve Initial Disclosures, deem Opposer’s First Requests for Admission admitted, compel Applicant to respond without objection to Opposer’s First Set of Interrogatories and First Request for Production of Documents, and compel Applicant to produce responsive documents.

This the 10th day of March, 2010.

KILPATRICK STOCKTON LLP

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FABASOFT AG,	:	
	:	
Applicant.	:	
-----X	X	

CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing OPPOSER'S MOTION AND BRIEF IN SUPPORT FOR AN ORDER DEEMING ITS REQUESTS FOR ADMISSION ADMITTED, TO COMPEL RESPONSES TO ITS INTERROGATORIES AND REQUESTS FOR PRODUCTION, AND TO COMPEL PRODUCTION OF DOCUMENTS has been served on counsel for Fabasoft AG by depositing said copy with the United States Postal Service as First Class Mail, postage prepaid, in an envelope addressed to:

Stewart J. Bellus
Collard & Roe, P.C.
1077 Northern Blvd
Roslyn, NY 11576-1614

This the 10th day of March, 2010.

/s/ Alicia Grahm Jones
Alicia Grahm Jones
Attorney for Opposer Apple Inc.